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10/647,383	08/26/2003	Kotaro Kaneko	1011350-000320	2047
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EXAMINER SHAN, APRIL YING				
ART UNIT 2492		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/647,383

Applicant(s)

KANEKO, KOTARO

Examiner

APRIL Y. SHAN

Art Unit

2492

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11-14, 19 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-14, 19 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-845)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 8 November 2010, has been received, entered into the record, respectfully and carefully considered.
2. As a result of the amendment, claims 1, 2, 11, 19 and 24 are amended. Claims 5-10, 15-18 and 20-23 are canceled. No new claim is added. Thus, claims 1-4, 11-14, 19 and 24-26 are now presented for examination.
3. Any claim objection/rejection not repeated below is withdrawn due to Applicant's amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4, 11-14, 19 and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 11 and 19 have been amended to recite "inhibiting every program that is judged to be the illegal program from being run on said controlling apparatus". However, there is no concrete support in the specification explicitly disclosing the noted step. Also, the dependent claims 2 and 24 recite "inhibiting the illegal program includes automatically deleting

or isolating the illegal program". Note that inhibiting has a broader scope than "automatically deleting or isolating" recited in the application. For example, "inhibiting" can cover manually deleting or isolating, automatically/manually returning the applications and etc. which are not supported in the specification. Appropriate clarification is required.

Any dependent claims which were not directly rejected above are rejected at least by virtue of dependency.

Response to Arguments

6. Applicant's arguments filed 8 November 2010 have been fully considered but they are not persuasive.

7. The Applicant's arguments summarized as below:

a. The Applicant argues on pages 11-13 of the remark, Geiger, Radatti and Motoyama does not disclose or suggest amended claim limitations of any program which is not included in the preset list of programs that are authorized to be run to control the image forming apparatus, is judged as an illegal program resulting from a computer virus infection and every program that is judged to be an illegal program is inhibited from being run the controlling apparatus

b. The Applicant argues on pages 12-13 of the remark, the dependent claims 2-4, 12-14 and 24-26 are allowable due to dependency on claims 1, 11 and 19.

In response to argument 'a', the examiner respectfully disagrees. The examiner begins by considering the scope and meaning of the terms "**any**", "**every**" and "**inhibited** from being run" which must be given their broadest reasonable interpretation consistent with Applicant's disclosure, as explained in *In re Morris*, 127 F. 3d 1048, 1054 (Fed. Cir. 1997) and see also *In*

re Zletz, 893 F. 2d 319, 321 (Fed. Cir. 1989), in which stating the claims must be interpreted as "broadly as their terms reasonably allow".

Applicant's specification states the following:

[0010] and [0011], The computer program further executes a procedure of judging a program/file, which is not included in a preset list of programs/files that can be run to control the image forming apparatus

[0035] and [0036], **one or more** files that are judged as illegal files are **deleted or isolated** into isolation folder

The examiner further states, "the ordinary meaning of a claim term is its meaning to the ordinary artisan after reading the entire patent." Philips V. AWH Corp., 415 F. 3d 1303, 1321 (Fed. Cir. 2005).

Upon reviewing Applicant's Specification, the examiner fails to find any definition of the terms "any", "every" and "inhibited from being run" – that are different from the ordinary meaning. The examiner finds the ordinary meanings of these terms are best found in the dictionary. The examiner notes that the definition most suitable for "**any**" is one, some, or indiscriminately of whatever quantity, such as one or more, a or some without reference to quantity or extent. "**Every**" means complete or entire or all or each and "**inhibited from being run**" is forbidden, prohibited, hindered, restrained, or prevented from executing/running. Consequently, the examiner construes "any program which is not included in the preset list of programs that are authorized to be run to control the image forming apparatus, is judged as an illegal program resulting from a computer virus infection and every program that is judged to be an illegal program is inhibited from being run the controlling apparatus" is a or some program

which is not included in the preset list of programs that are authorized to be run to control the image forming apparatus, is judged as an illegal program resulting from a computer virus infection and any/every/each/complete/entire program that is judged to be an illegal program is forbidden, prohibited, hindered, restrained, or prevented from executing/running.

Geiger discloses pre-verification of **applications** (e.g. Title and page 1, lines 2-7 of Geiger), for running of an application, a check is made against the list 33 in the SIM 15 to verify **whether the application is authorized for running** – lines 10-12, page 4, if no list entry for the object is present – e.g. line 10, page 6. Further, in fig. 3 of Geiger, Return step 230 suggests it is an iterative process. In other words, each application included the applications must go through the process of verification before executing/running. Also, each program considered not on the list (step 220 in fig. 3 of Geiger) and not verified (step 222 in fig. 3 of Geiger) will be prevented from executing and directed to the return step 230 for the next application to go through the pre-verification process.

Clearly, Geiger's verification of applications prior to running on a processor and each program/application considered not on the list (step 220 in fig. 3 of Geiger) and not verified (step 222 in fig. 3 of Geiger) will be prevented from executing and directed to the return step 230 for the next program/application to go through the pre-verification process teaches a or some program which is not included in the preset list of programs that are authorized to be run to control the apparatus, is judged as an illegal program and any/every/each/complete/entire program that is judged to be an illegal program is forbidden, prohibited, hindered, restrained, or prevented from executing/running on a processor.

Furthermore, Radatti discloses in par. [0068], “**any** anomalous file(s) (e.g. **viruses**, **Trojan Horses**, etc) may be automatically deleted and an automatic delete component will delete **any** dangerous file(s) from the system”, which met the claimed limitation that an illegal program resulting from a computer virus infection. Finally, Motoyama et al. teaches monitoring programs running on an image forming apparatus by disclosing monitoring a software program running on an image forming apparatus (e.g. abstract of Motoyama et al.).

Thus, contrary to Applicant’s argument, Geiger, Radatti and Motoyama do disclose or suggest amended claim limitations of any program which is not included in the preset list of programs that are authorized to be run to control the image forming apparatus, is judged as an illegal program resulting from a computer virus infection and every program that is judged to be an illegal program is inhibited from being run the controlling apparatus.

In response to argument ‘b’, the examiner respectfully disagrees. Applicant’s argument for claims 1, 11 and 19 as discussed above are traversed and therefore, the Applicant's arguments for dependent claims are based on dependency on claims 1, 11 and 19 are traversed and they are not allowable.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. Claims 1-3, 11-13, 19 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger (WO 00/72149 A1) in view of Radatti (U.S. Pub. No. 20030140049) and further in view of Motoyama et al. (U.S. Patent No. 7,743,133).

As per **claims 1, 11 and 19**, Geiger discloses a computer program/method/apparatus for controlling apparatus executing the procedures of:

storing a preset list of programs that are authorized to be run on said controlling apparatus (microprocessor 12 – e.g. line 10, page 4) to control computer systems (Illustrated in SIM 15 is a list 33 of authorized applications – e.g. lines 2-3, page 4);

confirming each program running on said controlling apparatus (In operation, the mobile communication device is powered up and applications are loaded from the program memory into the microprocessor – e.g. lines 8-10, page 4);

judging any program, which is not included in the preset list of programs that are authorized to be run to control the computer systems among programs whose running states have been confirmed, (for running of an application, a check is made against the list 33 in the SIM 15 to verify **whether the application is authorized for running** – lines 10-12, page 4, if no list entry for the object is present – e.g. line 10, page 6 and pre-verification of **applications** - e.g. Title and page 1, lines 2-7); and inhibiting every

program that is judged to be an illegal program from being on said controlling apparatus (in fig. 3 of Geiger, Return step 230 suggests it is an iterative process. In other words, each program must go through the process of verification before running. Also, each program considered not on the list (step 220 in fig. 3 of Geiger) and not verified (step 222 in fig. 3 of Geiger) will be prevented from executing on a processor and directed to the return step 230 for the next program to go through the pre-verification process)

Although Geiger discloses if no list entry for the object is present, full signature verification is performed. If the digital signature is not verified, the application is not launched (e.g. lines 10-12 and lines 18-19, page 6). Once the signature is not verified, the program is considered as an unauthorized or illegal program and the application is not launched (e.g. lines 10-12 and lines 18-19, page 6), Geiger does not explicitly disclose the application as an illegal resulting from a computer virus infection. Radatti, however, met the claimed limitation by teaching to discover anomalous files, e.g., viruses, Trojan Horses, etc and they were not been present in the initial secure system data file – e.g. par. [0045] and once a comparison cycle is run, any anomalous files may be automatically deleted, **any** anomalous file(s) (e.g. **viruses, Trojan Horses, etc**) may be automatically deleted and an automatic delete component will delete **any** dangerous file(s) from the system - e.g. par. [0068] of Radatti).

Geiger – Radatti are analogous art because they are from a similar field of endeavor in monitoring mechanism. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the teachings of Geiger with the application as an illegal resulting from a computer virus infection taught by Radatti.

The motivation of doing so would have been for securing, maintaining, monitoring and controlling computer systems (e.g. par. [0001] of Radatti).

Geiger – Radatti does not explicitly disclose monitoring programs running on an image forming apparatus. However, Motoyama et al. met the claimed limitation by disclosing monitoring a software program running on an image forming apparatus (e.g. abstract).

Geiger – Radatti – Motoyama et al. are analogous art because they are from a similar field of endeavor in monitoring mechanism. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the teachings of Geiger - Radatti with monitoring a software program running on an image forming apparatus taught by Motoyama et al. in order to evaluating how a user utilizes a software application running on an image forming apparatus (e.g. col. 2, lines 15-19).

As per **claims 2, 12 and 24**, Radatti further discloses executes a procedure of inhibiting the illegal program includes automatically deleting or isolating the file that is judged as illegal file (once a comparison cycle is run, any anomalous files may be automatically deleted - e.g. par. [0068]).

As per **claims 3, 13 and 25**, Radatti further discloses wherein the procedure of judging includes a procedure of comparing the name of each file whose existence has been confirmed with the name of each file included in said list (compare file names - e.g. par. [0015]).

11. Claims 4, 14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger (WO 00/72149 A1) in view of Radatti (U.S. Pub. No. 20030140049) and in view of

Motoyama et al. (U.S. Patent No. 7,743,133).and further in view of Cozza (U.S. Patent No. 5,649,095).

As per **claims 4, 14 and 26**, Although Radatti discloses judging includes a procedure of comparing the name of each file whose existence has been confirmed with the name of each file included in said list (compare file names - e.g. par. [0015]), Geiger – Radatti – Motoyama et al. does not explicitly disclose comparing the size of each file whose existence has been confirmed with the size of each file included in said list. However, Cozza met the claimed limitation by teaching scanning files for computer viruses which use the length of at least one portion (such as a fork) of a file. This length information is stored in a cache. During a scan, the then current size of the file portion is compared to the length stored in the cache and if there is a size difference, the file is then scanned for virus which can change that portion of the file's size (e.g. abstract and col. 3, line 62 - col. 4, line 17 of Cozza).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Cozza's comparing the size of each file whose existence has been confirmed with the size of each file included in said list into Geiger – Radatti – Motoyama et al.. The motivation of so would have been to guarantee a great scanning speed increase by eliminating unnecessary, repeat scanning in return for a very modest cost (e.g. col. 4, lines 13-16 of Cozza).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 9:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2492

/Aravind K Moorthy/
Primary Examiner, Art Unit 2492